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<b>TRANSMITTAL FORM</b> <i>(to be used for all correspondence after initial filing)</i>		Application Number	09/312,740
		Filing Date	5/14/1999
		First Named Inventor	Douglas F. Beaven
		Art Unit	3623
		Examiner Name	Heck, Michael C.
Total Number of Pages in This Submission	13	Attorney Docket Number	beaven01.001

**ENCLOSURES** *(Check all that apply)*

- |  |   |  |
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| <input type="checkbox"/> Fee Transmittal Form                                | <input type="checkbox"/> Drawing(s)                                       | <input type="checkbox"/> After Allowance Communication to Group                            |
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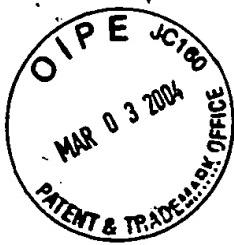
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## **Response to restriction requirement under 37 C.F.R. 1.142**

### **Summary of the prosecution**

- 20 On 12/30/02, Examiner mailed a first Office action in the above application in which he required a new Declaration, required correction of the Drawing as specified in the *Notice of Draftperson's patent drawing review*, PTO-948, objected to the Drawing as having two identical figures, and required correction of the drawing; objected to the Specification; and objected to various informalities in claims 11, 12, 13, 14, 26, 27, 28, and 43.

25 Examiner further rejected claims 2-23, 39-62, 64-94, and 96-125 for indefiniteness under 35 U.S.C. 112, second paragraph, rejected claims 1, 24, 28, 29, 31, 34, 35-37, 38, 63, and 95 under 35 U.S.C. 103(a) as obvious over Lowery, *Managing projects with Microsoft Project 4.0 for Windows and Macintosh*, version 4.0, Van Nostrand Reinhold, 1994 (henceforth "Lowery"), rejected claims 25, 33, and 36 under 35 U.S.C. 103(a) as being unpatentable over Lowery combined with *ManagePro 2.0 for Windows*, version 2.0, *Reference Manual*, Avantos Performance Systems, Inc., 1993 (henceforth "Managepro"), and rejected claims 26, 27, 30, and 32 under 35 U.S.C. 103(a) as obvious over Lowery in combination with published U.S. patent application 2001/0027455, Abulleil et al., having an effective filing date of 8/21/98 (henceforth "Abulleil").

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35 Applicant amended his Specification, Drawing, and claims to overcome the objections thereto and traversed the rejections of the claims under 35 U.S.C. 112, second paragraph and 35 U.S.C. 103(a) in a response filed on 4/28/03 with a one-month extension of time.

Applicant received a second non-final Office action in the above application mailed 7/16/03. In the second Office action, Examiner indicated that Applicant's traversal of the rejections had been persuasive. Examiner objected to the Specification and Drawing on 5 the basis of further errors and objected to claims 14, 19, 85, 86, and 122 because of informalities. In his new grounds of rejection, Examiner rejected claims independent claims 1, 38, 63, and 95 as lacking patentable utility and as being addressed to non-patentable subject matter. The dependent claims were rejected as being dependent on claims 1, 38, 63, and 95.

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Examiner further rejected claims under 35 U.S.C. 103 as follows:

- Claims 1-26, 28, 29, 31, 34-62, and 95-125 as being unpatentable over Lowery in view of Pearce, et al., *Strategic Management: Formulation, Implementation, and Control*, 4th edition, Richard D. Irwin, Inc., 1991, henceforth "Pearce".
- 15 • Claim 30 as being unpatentable over Lowery in view of N. Tatum, *Verity and Yahoo! Inc. Sign Distribution Agreement*, Verity, Inc., Sunnyvale, CA, April 12, 1999, henceforth "Tatum".
- Claims 32 and 33 as being unpatentable over Lowery in view of *Managepro 2.0 Reference Manual* (Managepro 2.0 for Windows, version 2.0, Reference Manual, 20 Avantos Performance Systems, Incorporated, 1993), henceforth "Managepro"
- Claims 63-94 are rejected as being unpatentable over Lowery in view of Pearce and Carter, "As program management Function evolves, Benefits Increase", *Water Engineering and Management*, Des Plaines, Vol. 142, issue 3, Mar. 1995.

Applicant rendered the foregoing rejections moot by replacing the claims then in the 25 application in the application with a new set of claims 126-186. In replacing the present claims, Applicant was by no means conceding the correctness of Examiner's rejections of the present claims, but rather merely taking advantage of his right to claims which set forth his invention in the most advantageous manner.

30 Applicant next received a restriction requirement in the application in which Examiner determined that the original claims were classified in class 705, subclass 7, while the new

claims 126-186 were classified in class 709, subclass 204. Examiner further determined that since Applicant had already received an action on the original claims, Applicant had constructively elected the invention of the original claims for prosecution on the merits. On the basis of that determination, Examiner withdrew new claims 126-186 from  
5 consideration as being directed to a non-elected invention.

Applicant is responding to the restriction requirement by canceling claims 126-186 without prejudice and adding new claims 187-210 which should be classified in class 705, subclass 7 and thereby overcome the restriction requirement. Applicant will further  
10 demonstrate why the new claims are patentable over the references.